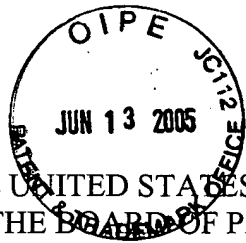


CERTIFICATE OF MAILING BY FIRST CLASS MAIL (37 CFR 1.8)			Docket No.	
Applicant(s): Robert B. Hope			ULB-003CV	
Application No. 10/033,518	Filing Date 12/28/2001	Examiner Jerry E. Redman	Customer No. 024,902	Group Art Unit 3634
Invention: WEATHER SEAL HAVING ELASTOMERIC MATERIAL ENCAPSULATING BENDABLE CORE				
<p>I hereby certify that this <u>APPEAL BRIEF UNDER Rule 41.37 (in triplicate)</u></p> <p>(Identify type of correspondence)</p> <p>is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on</p> <p><u>June 9, 2005</u></p> <p>(Date)</p> <p><u>Tammy S. Moynihan</u></p> <p>(Typed or Printed Name of Person Mailing Correspondence)</p> <p><u>Tammy S. Moynihan</u></p> <p>(Signature of Person Mailing Correspondence)</p> <p>Note: Each paper must have its own certificate of mailing.</p>				



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Robert B. Hope
Serial No.: 10/033,518 Confirmation No. 8646
Filed: December 28, 2001
For: WEATHER SEAL HAVING ELASTOMERIC MATERIALS
ENCAPSULATING A BENDABLE CORE
Examiner: Jerry E. Redman Art Unit: 3634
Atty. Docket: ULB-003CV

APPEAL BRIEF UNDER Rule 41.37

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant respectfully submits the following brief in support of his appeal of the Final Rejection of Claims 1-10 (all of the claims now standing) in the above-identified application.

(1) Real Party In Interest

Applicant's Assignee, Ultrafab, Inc., of Farmington, New York, is the Real Party In Interest in this case.

(2) Related Appeals and Interferences

There are no Appeals or Interferences related to this Appeal or to this application.

(3) Status of Claims

Claims 1-10 are pending and all of these claims are forwarded for consideration on this Appeal.

(4) Status of Amendments

A Response was filed on February 11, 2003 to the First Final Rejection of January 23, 2003. The claims were not amended in this Response. The Response contains

reasons, both factual and legal, supporting the allowance of the claims which were finally rejected and are now on appeal.

In an Advisory Action dated March 5, 2003, the Examiner maintained his Final Rejection stating, "the claims still read on the art of record".

On or about March 10, 2003, Counsel contacted the Examiner and attempted to ascertain the basis of the Examiner's statement in the Advisory Action. No cognizant reasons were solicited thereby predicated this Appeal.

On July 16, 2003, the Examiner issued a non-final Action citing new references and combining them to reject all of the claims under 35 U.S.C. §103(a).

In a Request for Reinstatement of Appeal and Supplemental Brief filed September 5, 2003, it was contended that reopening of prosecution only merely presenting a new non-final Action was out of order. That Request for Reinstatement and Supplemental Brief is hereby incorporated by this reference in this Second Supplemental Appeal Brief.

On June 23, 2004 (Paper 12) the Examiner responded by requiring a "new and complete brief in response to the rejection dated July 16, 2003" (the new non-final action discussed above).

The Second Supplemental Brief was submitted on July 23, 2004. As was the case after the first Appeal Brief, the Supplemental Appeal Brief was not entered or docketed.

Instead, after over three (3) years of prosecution, the Examiner issued a new non-final Action on October 20, 2004, which relied upon a new reference, a 1996 Japanese document to Iwasa, even though most of the claims were not changed since November 2002, and no reason for such lateness of citation was offered by the Examiner.

A response to the October 20, 2004 Action was filed on December 10, 2004. On March 9, 2005, the Examiner issued the second Final Rejection. New references were cited in this second Final Rejection resulting in the second and new Appeal.

This Appeal is of the latest Final Rejection of March 9, 2005.

(5) Summary of Claimed Subject Matter

This invention relates to weather seals for sealing body parts such as windows, doors and trunks of automotive vehicles (cars and trucks) (page 1, first paragraph). The invention has two aspects. The first deals with the encapsulation of the core (the wire

carrier 12, FIGS. 2 and 3) with a substrate or encapsulating filler 20 of recycled elastomeric material which is then covered with virgin elastomeric material (paragraph bridging pages 2 and 3, FIGS. 2 and 3, fourth full paragraph on page 6). Preferably, as shown in FIGS. 3 and 4, the substrate is applied as tape; preferably extruded as molten tapes 30 and 32 sandwiching the core or carrier 12 and its reinforcing elements 14 (paragraph bridging pages 6 and 7 and first full paragraph on page 7).

The principal advantage of the use of the substrate is to reduce the cost of the weather seal. Other advantages are to improve the integrity of the weather seal. These advantages are described from lines 5-25 on page 3.

The second aspect of the invention is to provide a core and carrier which avoids the need for reinforcement elements of knitted yarn (paragraph bridging pages 3 and 4). These reinforcement elements 42 are laid down only on one side of the core (the loops of the carrier 12) (page 7, lines 16 and 17). The core 12 is carried around a wheel 56 and the plurality of reinforcing elements 90 are fed onto one side of the elements on the wheel. The elements are attached to the core at a processing station 80 (FIG. 8A) as by glue from a dispenser 84 (see FIG. 11). The substrate and sealing layers are then applied over the core and the reinforcing elements (the summary and last full paragraph on page 4, and first full paragraph on page 8).

(6) Grounds for Rejection

(i) An issue presented by the Final Rejection of March 9, 2005 is whether Claims 5-7 and 9-10 express the invention set forth therein pursuant to 35 U.S.C. 112(2).

(ii) Another issue presented by the Final Rejection of March 9, 2005 is whether any of the claims are unpatentable over Keys, U.S. Patent No. 5,221,564 in view of a Japanese Patent JP 0812815, and in the case of Claims 2, 6, 7, 9 and 10 also in view of Vinay, U.S. Patent No. 5,416,961.

(7) Argument

(7)(i) Grouping of Claims

The first aspect of the invention is set forth in Claims 1-4 and 8. Claims 1 and 2 feature the dual use of recycled elastomeric material as the substrate and virgin material as the cover. An important feature of the invention is to provide the substrate of recycled

elastomeric material in the form of a tape or tapes which encapsulate the core and this aspect is in Claims 3, 4 and 8. Another group is of Claims 5-7, 9 and 10. These are product by process claims which define the weather seal in terms of the use of a wheel to carry the core and define a space where the reinforcing elements are applied, the nature of these elements and the process by which they are attached, namely application of adhesive, fusion bonding, or encapsulation.

With respect to the claim rejections, the claims do not stand or fall together, and are in three claims groups:

Group I - Claims 1 and 2;

Group II - Claims 3, 4 and 8; and

Group III - Claims 5-7, 9 and 10.

(7)(ii) Argument over Rejection of Paragraph 6(i)

As regards the first issue, Claims 5-7, 9 and 10 are simply product by process claims. These claims are clearly understandable. No question has been raised as to clarity of the process limitations. Such limitations should not be ignored (which the Examiner appears to have done here). Accordingly, the 35 U.S.C. §112(2) rejection is respectfully submitted not to be well taken and this rejection should be reversed.

(7)(iii) Argument over Rejection of Paragraph 6(ii)

The rejection on Keys in view of Iwasa under 35 U.S.C. §103(a) is in error since there is no showing of a substrate layer of recycled elastomeric material which is encapsulated by a covering of virgin elastomeric material, let alone the use of tapes of the recycled material, and the antithesis of what is claimed is shown in Iwasa, i.e., recycled elastomeric material (rubber) is used over a substrate of virgin rubber. Applicant claims quite the opposite relationship. Moreover, the references cited in the Final Rejection are merely general discussions of recycled rubber, and are not relevant to what Applicant claims. All the references would not even constitute a *prima facie* case of obviousness. See In re Rijckaert, 9 F.3d 1531,1532, 28 U.S.P.Q. 2d, 1955, 1956 (Fed. Cir. 1993).

The Examiner cites, in the second Final Rejection, a litany of papers on use of recycled rubber. Such general references would not constitute evidence that would lead one of ordinary skill in the art to combine any such general references, or teachings

thereof with Keys, let alone Iwasa, a reference which teaches away from what is claimed, to arrive at the claimed invention. See In re Fine, 837 F.2d 1071,1074, 5 U.S.P.Q. 2d, 1596,1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013,1016, 173 U.S.P.Q. 560,562 (CCPA 1972).

More specifically, Iwasa uses new rubber, which is merely coated with crushed vulcanized rubber and the composite is pressure molded to provide a molding of the composite material.

(7)(iv) Claims 1 and 2, and Claims 3, 4 and 8

The concept of covering a substrate over a core with a covering of “virgin elastomeric material” to provide a sealing surface is not present in Iwasa. Since Iwasa vulcanizes the entire body under pressure, a new element is formed, and the “covering” discussed by the Examiner is gone. Certainly the use of tapes of the elastomeric material is not foreshadowed (Claims 3, 4, and 8).

The Examiner is also in error as to his interpretation of Keys. Keys shows no encapsulation layers. Layer 17 butts against the end of layer 21 at a butt joint 32. Layer 17 is of thermo setting material (noted as EPDM-apparently virgin material). Layer 21 is of thermo plastic (PVC). There are no tapes of recycled EPDM in the Keys seal. There is no encapsulating layer of virgin EPDM. More specifically, Keys’ layers are side by side, not in “encapsulating” relationship as contended by the Examiner in constructing his rejection. The rejection is, for the reason above, not well taken.

Claims 1, 3 and 8 call for a substrate of recycled elastomeric material which is encapsulated by virgin material. The Japanese reference is for an integrally formed structure, nothing like what is claimed. It is beyond peradventure that there is nothing except Applicant’s disclosure to suggest (i.e., in hindsight) using a substrate of recycled material over a core covered by an encapsulating layer, let alone specifically as claimed. Clearly, the combination of references is improper under a long line of cases including In re Vaeck, 20 U.S.P.Q. 2d 1438, 1442 (Fed. Cir. 1991).

(7)(v) Claims 5, 6, 7, 9 and 10, and Claim 8

The rejection of Claim 5 and Claims 6, 7, 9, and 10 dependent thereon is in error in that none of the references disclose the use of a wheel for carrying a weather seal core

and applying reinforcing elements to one side of the core as the wheel rotates. Claim 5 defines a weather seal made by applying reinforcing elements along only one side of a core. Claim 5 and dependent Claims 6-7 and 9-10 are separately patentable from other claims on Appeal by describing the applying and attaching of reinforcing elements.

The Examiner is in error in applying the Vinay patent in that Vinay shows only a woven warp of threads including a wire and a meltable thread. Vinay is discussed and distinguished from the invention claimed by Appellant on page 2, first full paragraph of the specification as filed. Certainly Vinay does not teach anything about the core encapsulating layers of recycled and virgin elastomeric material. The warp is not on one side of the core, but is woven around the core wire. Thus, Claims 5, 6, 7, 9, and 10, and also Claim 8 clearly distinguish by virtue of the unique location of the reinforcing elements unforeshadowed in any reference of record.

For the foregoing reasons, the decision of the Examiner rejecting Applicant's claims should be reversed and the Examiner should be directed to pass this case to Issue.

Dated: June 9, 2005

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Martin LuKacher', written over a horizontal line.

Martin LuKacher
Attorney for Applicant
Registration No. 17,788

South Winton Court
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APPENDIX
Claims On Appeal

1. A weather seal comprising a core, a substrate of recycled elastomeric material encapsulating said core, a covering of virgin elastomeric material providing a sealing surface and encapsulating said core and substrate.

2. The weather seal according to Claim 1 where the core is a wire loop carrier.

3. The weather seal according to Claim 1 wherein the recycled material is cured EPDM or TPR which is applied in molten or semi-molten form as a tape or tapes.

4. The weather seal according to Claim 3 wherein the material is extruded to form said tape or tapes.

5. A weather seal comprising a core, longitudinal extension control and reinforcing elements applied along only one side of said core by carrying said core around a wheel which exposes a space thereof, applying said element through said space as said wheel rotates, and attaching said elements to said core in said space after application.

6. The weather seal according to Claim 5 wherein said core is a wire loop carrier and elements are yarns, selected from the group consisting of polyester strands, fiberglass strands, metal wires and monofilaments.

7. The weather seal according to Claim 6 wherein said attaching step is carried out by chemical bonding, with adhesive applied where said elements contact the core.

8. The weather seal of Claim 3, further comprising one or more reinforcement elements adjacent to and along the length of said core on only one side

thereof, said tape encapsulating said core and attaching said reinforcement elements to said core.

9. The weather seal of Claim 6 wherein said attaching step is carried out by fusion bonding.

10. The weather seal of Claim 6 wherein said attaching step is carried out by encapsulation of said elements and said core.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Robert B. Hope

Serial No.: 10/033,518

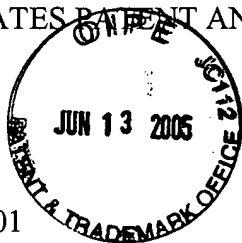
Filed: December 28, 2001

For: WEATHER SEAL HAVING ELASTOMERIC MATERIALS
ENCAPSULATING A BENDABLE CORE

Examiner: Jerry E. Redman

Art Unit: 3634

Atty. Docket: ULB-003CV



Confirmation No.: 8646

NOTICE OF APPEAL AND TRANSMITTAL OF APPEAL BRIEF (in triplicate)

Mail Stop Appeal Briefs - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant hereby appeals to the Board of Patent Appeals and Interferences from the last final rejection of the Examiner dated March 9, 2005 finally rejecting Claims 1-10 (all the claims in the case).

Applicant's Appeal Brief is also provided herewith.

Inasmuch as the initial Notice of Appeal and Appeal Brief mailed April 23, 2003 were not entertained and a Request for Reinstatement of the Appeal and Supplemental Brief mailed September 3, 2003 were not docketed or entertained by the Board, a credit is requested. \$320.00 was paid with the Notice of Appeal and first Appeal Brief and \$165.00 was paid for the Supplemental Appeal Brief. The amount therefore which is believed to be due for filing the Notice of Appeal and the Appeal Brief is \$500.00 minus \$485.00 or \$15.00.

The requisite fee should be charged to our deposit account No. 50-1101.

Adjustment date: 06/14/2005 MAHMED1
07/27/2004 SDIRETA1 00000038 501101 10033518
01 FC:2402 165.00 CR

Dated: June 9, 2005

Adjustment date: 06/14/2005 MAHMED1
04/29/2003 BNGUYEN1 00000044 10033518
01 FC:2401 -160.00 OP

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Martin LuKacher".

Martin LuKacher
Attorney for Applicant(s)
Registration No. 17,788

South Winton Court
3136 Winton Road South, Suite 204

Adjustment date: 06/14/2005 MAHMED1
04/29/2003 BNGUYEN1 00000044 10033518
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